

REMARKS

Before entry of this Amendment, claims 1-26 were pending in the application and claims 27 and 28 were canceled. After entry of this Amendment claims 1-26 remain pending under examination and claims 27 and 28 remain canceled. The number of total claims has not been increased, and the number of independent claims has not been increased beyond the number for which payment previously had been made.

In accordance with MPEP § 706.07(d), applicant hereby requests reconsideration of the finality of the October 2008 Action on the basis that the final rejection of claim 25 based on the newly cited Taylor reference was premature.

In the first Office Action, which was mailed on February 26, 2008, claim 25 was rejected under 35 U.S.C. § 112, second paragraph, because the language was vague and unclear. The February 2008 Office Action also rejected claims 27 and 28 under 35 U.S.C. § 102(b) based on Haber et al (USP 4,850,953). In response to this February 2008 Office Action, the applicant amended claim 25 to remove the indefiniteness, incorporated the limitations of claims 27 and 28 into claim 25 as part of a Markush group and cancelled claims 27 and 28.

The October 2008 Office Action withdrew the Section 112, second paragraph rejection of claim 25, but entered the new rejection of claim 25 under 35 U.S.C. § 103(a) based on Haber et al (USP 4,850,953) and the newly cited prior art to Taylor (USP 5,935,107). However, the Examiner made this October 2008 Office Action final. Applicant respectfully requests withdrawal of the finality of this October 2008 Office Action.

Per MPEP § 706.07(a):

a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by Applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Applicant's amendment of claim 25 was merely to eliminate indefiniteness. Thus, the new ground of rejection of claim 25 was not necessitated by Applicant's Amendment. Had the reference to Taylor been cited in the February 2008 Office Action, applicant would have been afforded the opportunity to respond on the merits to the non-final rejection of claims 25, 27 and 28 based on the combination of Haber et al and Taylor. Thus, the October 2008 Action is in reality only the first action on the merits as to claim 25 for the combination of Haber et al and Taylor. Applicant was not afforded the opportunity to address the rejection of claim 25 based on the newly cited Taylor reference in a non-final action. Applicant respectfully submits that the effect of making this October 2008 Action final, is to prematurely cut-off the applicant's prosecution of his application in contravention of the requirements of MPEP § 706.07(a) quoted above.

Applicant therefore respectively requests the Examiner to withdraw the finality of the October 2008 Action.

Applicant has carefully considered the Examiner's Action of October 24, 2008, and the references cited therein. The following is a brief summary of the Action. Objection was made to the disclosure because the specification did not include the continuity date of the parent applications. Objection was made to the drawings under 37 C.F.R. 1.83(a) because "pair of electrodes" and "support" are claim elements that are not depicted in the drawings. Claims 1-3, 6-17, 19, 21-24 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Haber et al (USP 4,850,953). Claims 4 and 5

were rejected under 35 U.S.C. 103(a) as being unpatentable over Haber et al. Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over Haber et al in view of Elbert et al (US 2002/0165553). Claim 20 was rejected under 35 U.S. C. 103(a) as being unpatentable over Haber et al in view of Buckholtz et al (USP 5,409,006). Claim 25 was rejected under 35 U.S. C. 103(a) as being unpatentable over Haber et al in view of Taylor (USP 5,935,107).

In response to the objection to the disclosure, applicant has amended the specification to include the continuity data of the parent applications. Accordingly, this amendment responding to this matter of form should be entered, and withdrawal of the objection to the specification is respectfully requested.

In response to the objections to the drawings, applicant has amended the drawings, the specification and claim 26 to overcome the objections. Accordingly, this amendment responding to these matters of form should be entered. Specifically, applicant has amended Figs. 1 and 2 of the drawings to show schematically a "pair of electrodes" 25 and lead lines 26 in accordance with page 8, line 36 through page 9, line 4 of the specification and has amended page 8, line 36 through page 9, line 4 of the specification to add the numerals 25 and 26 where appropriate. Applicant has amended the paragraph of the Specification beginning at line 6 on page 9 to clarify that the receptacles and carriers are examples of the bodies 23 illustrated in Fig. 3 and has accordingly amended claim 26 to change "support" to "carrier." In so doing, applicant noticed that the body 23 in Fig. 3 had been inadvertently omitted from the replacement Sheet submitted with the Amendment filed in June 2008 and accordingly hereby resubmits a corrected Replacement Sheet for Fig. 3. Applicant therefore respectfully

requests withdrawal of the objections to the drawings and submits that the foregoing changes do not add new matter.

For the reasons explained below, applicant respectfully traverses the rejection of claims 1-3, 6-17, 19, 21-24 and 26 under 35 U.S.C. § 102(b) as being anticipated by Haber et al.

The present invention pertains to a device for tamponade of body cavities and mechanical anchoring of a catheter. To tamponade a body cavity means to fill that cavity.

Haber et al discloses a valve through which liquid nourishment can be delivered through the abdominal wall 50 and abdominal mucosa 52 of a baby that otherwise is unable to eat normally via the mouth and esophagus.

The last paragraph on page 3 of the Office Action contends that (emphasis added):

Haber discloses a device (1) for tamponade of body cavities and securement thereto, comprising a flexible tube segment (8) having an inner wall and an outer wall that surrounds an inner space, wherein the tube segment is inflatable and configured **without any support bodies** so that displacement of the tube wall is possible as inflation proceeds,

However, claim 1 requires the flexible tube segment to be configured **without through-passing support bodies** so that a displacement of tube wall material between the inner wall and the outer wall of the tube segment is possible as inflation proceeds. Thus, as explained in applicant's specification, claim 1 precludes any support bodies extending through the central lumen of the torus geometry.

At lines 7-14 of the Response to Argument section on pages 6-7 of the October

2008 Final Action, it is stated that the examiner:

agrees with the applicant's assertion that elements (6, 7) can be considered "through-passing support bodies", but the examiner is interpreting the claim to mean that there are no such bodies between the inner and outer wall of the flexible tube segment. The examiner contends that there are no such bodies within the wall of the defined flexible tube segment (a) as elements (6, 7) lie outside the wall of element (a). For these reasons, the examiner has maintained the rejection. The examiner suggests reciting that there are no support bodies between the internal area defined by the inner wall.

As suggested by the Examiner, applicant has amended claim 1 to clarify that there are no support bodies between the internal area defined by the inner wall. Entry of this clarifying amendment is respectfully requested as it merely eliminates any ambiguity in claim 1 and places the case into condition for allowance.

Reference to Haber et al Figs. 2, 3 and 4 for example shows that Haber et al fails to satisfy this requirement of the flexible tube segment being configured **without through-passing support bodies**. For the Haber et al feeding lumen 6 with its tapered distal nose 7 constitutes just such a **through-passing support body** that claim 1 precludes.

This claim 1 feature is explained at page 5, lines 28-30 in applicant's specification as follows:

However, when deflated, the stretched-out double tube body does have a certain rigidity due to the close mutual contact of four wall layers, that alone makes it possible to position it for most applications.

This condition cannot be achieved by the Haber et al device. For in the Haber et al device, there is a through-passing support body that takes the form of the rigid stem 6, 7

in the middle. Because of this rigid stem 6, 7, any close mutual contact of four wall layers is precluded in the Haber et al device.

According to claim 12 (emphasis added), the

tube section is preformed in such a way that a tube portion that forms the inner wall of said tube segment after invagination is smaller in cross-section and has a **greater wall thickness** than a tube portion forming the outer wall.

The walls of the Haber et al balloon 8 are of uniform thickness, and therefore Haber et al fails to disclose the above-quoted feature of claim 12.

Applicant therefore respectfully submits that claims 1-3, 6-17, 19, 21-24 and 26 are patentable under 35 U.S.C. § 102(b) over Haber et al.

Since Haber et al is deficient as noted above with respect to claim 1, and claims 4 and 5 depend from claim 1, applicant therefore respectfully submits that claims 4 and 5 are patentable under U.S.C. § 103(a) over Haber et al.

For the reasons explained below, applicant respectfully traverses the rejection of claim 18 under 35 U.S.C. 103(a) as being unpatentable over Haber et al in view of Elbert et al.

Elbert et al fails to correct the deficiencies noted above in Haber et al. Applicant therefore respectfully submits that claim 18 is patentable under U.S.C. § 103(a) over Haber et al in view of Elbert et al.

For the reasons explained below, applicant respectfully traverses the rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Haber et al in view of Buckholtz et al.

Buckholtz et al fails to correct the deficiencies noted above in Haber et al.

Applicant therefore respectfully submits that claim 20 is patentable under U.S.C. § 103(a) over Haber et al in view of Buckholtz et al.

For the reasons explained below, applicant respectfully traverses the rejection of claim 25 under 35 U.S.C. 103(a) as being unpatentable over Haber et al in view of Taylor.

Taylor fails to correct the deficiencies noted above in Haber et al. Applicant therefore respectfully submits that claim 25 is patentable under U.S.C. § 103(a) over Haber et al in view of Taylor.

Applicant respectfully requests reconsideration and reexamination of claims 1-26, as presented herein, and submits that these claims are in condition for allowance and should be passed to issue.

If any fee or extension of time is required to obtain entry of this Amendment, the undersigned hereby petitions the Commissioner to grant any necessary time extension and authorizes charging Deposit Account No. 04-1403 for any such fee not submitted herewith.

Respectfully submitted,

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Date:

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